

ESTTA Tracking number: **ESTTA725440**

Filing date: **02/07/2016**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	CONAN DOYLE ESTATE LIMITED
Granted to Date of previous extension	02/07/2016
Address	9 LONDON RD SOUTHAMPTON, SO152AE UNITED KINGDOM
Attorney information	BENJAMIN ALLISON BARDACKE ALLISON LLP 515 DON GASPAR, Second Floor SANTA FE, NM 87505 UNITED STATES ben@bardackeallison.com, breanna@bardackeallison.com, kelly@bardackeallison.com Phone:505-386-4100

### Applicant Information

Application No	86603772	Publication date	08/11/2015
Opposition Filing Date	02/07/2016	Opposition Period Ends	02/07/2016
Applicant	Universal City Studios LLC 100 Universal City Plaza Universal City, CA 91608 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0


All goods and services in the class are opposed, namely: Pre-recorded media, namely, digital, audio, and video tapes and discs, CDs, DVDs, and MP3-players featuring books, music, television programs, movies or other entertainment audio-visual programming in the field of animation, cartoons, drama, action, adventure, science-fiction, romance and suspense; musical sound recordings; downloadable motion pictures, television programs and audio-visual entertainment programs in the field of animation, cartoons, drama, action, adventure, science-fiction, romance and suspense; downloadable ring tones, computer screen saver software, music files, images and videos featuring animation, cartoons, drama, action, adventure, science-fiction, romance, suspense, movie clips, television show clips and music video clips via a global computer network and wireless communication devices; downloadable computer game, video game and electronic game programs and software via a global computer network and wireless communication devices; downloadable interactive computer game, video game and electronic game programs and software via a global computer network and wireless communication devices; downloadable computer game software for use on mobile phones, cellular phones and tablets; video game software provided on CD or DVD, cartridges, and memory cards; interactive computer game video game and electronic game programs and software provided on CD or DVD, cartridges, and memory cards; video game cartridges, and video game memory cards; com-

puter screen saver software; downloadable electronic publications, namely, series of fiction books, comic books and animated story books; mouse pads; protective carrying cases adapted for portable music players; protective covers and cases for mobile phones, tablets, and PDAs; speakers, audio headphones and earbuds; computer storage devices, namely, blank flash drives; calculating machines; decorative magnets; kitchen magnets; sunglasses; 3-D glasses; swim masks; mobile phone accessories namely, batteries, chargers, cables, phone cases, covers and gel-skins, phone charms, cell phone mounts for cars, phone clips and screen protectors; photographic cameras; radios


## Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution by tarnishment	Trademark Act section 43(c)
Fraud on the USPTO	In re Bose Corp., 580 F.3d 1240, 91 USPQ2D 1938 (Fed. Cir. 2009)


## Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	77937845	Application Date	02/17/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SHERLOCK HOLMES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Motion picture and television films featuring musical, dramatic, comedic and theatrical performance; prerecorded goods, namely, prerecorded audio and video cassettes, compact discs, and digital versatile discs all featuring audio books and stories in the field of detective fiction, motion picture and television films, animated cartoons, radio programs, music, and games; downloadable electronic publications in the nature of e-zines and electronic books in the field of detective fiction		

U.S. Registration No.	4690745	Application Date	11/22/2013
Registration Date	02/24/2015	Foreign Priority Date	NONE
Word Mark	SHERLOCK HOLMES		


Design Mark	
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2013/10/09 First Use In Commerce: 2013/10/09 Organisation of exhibitions for cultural, educational, and entertainment purposes

U.S. Registration No.	4313984	Application Date	10/14/2011
Registration Date	04/02/2013	Foreign Priority Date	NONE
Word Mark	SHERLOCK HOLMES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2012/12/03 First Use In Commerce: 2012/12/03 Electronic gaming machines, namely, devices that accept a wager		

U.S. Application No.	77937813	Application Date	02/17/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SHERLOCK HOLMES		
Design Mark			


Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 0 First Use In Commerce: 0 Printed matter, namely, books, short stories, magazines, and newsletters in the field of detective fiction; photographs; story books

U.S. Application No.	77937852	Application Date	02/17/2010
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	SHERLOCK HOLMES
Design Mark	 The design mark for the word 'SHERLOCK HOLMES' is displayed in a large, bold, serif font. The letters are black and set against a white background within the design mark box.


Description of Mark	NONE
Goods/Services	Class 028. First use: First Use: 0 First Use In Commerce: 0 Games and playthings, namely playing cards, board games, puzzles, and action figures

U.S. Application No.	77937863	Application Date	02/17/2010
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	SHERLOCK HOLMES
Design Mark	 The design mark for the word 'SHERLOCK HOLMES' is displayed in a large, bold, serif font. The letters are black and set against a white background within the design mark box.

Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Entertainment services, namely, production of motion pictures, television dramas, stage plays, and radio programs; entertainment services, namely, providing online electronic games, online computer games, and online video games

U.S. Application No.	85229790	Application Date	01/31/2011
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Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SHERLOCK HOLMES CONAN DOYLE ESTATE LTD		
Design Mark			
Description of Mark	The mark consists of the silhouette of Sherlock Holmes with deerstalker and pipe, superimposed over the profile of Sir Arthur Conan Doyle, surrounded by the circular text "SHERLOCK HOLMES" in bold and "CONAN DOYLE ESTATE LTD," and enclosed within a circle.		
Goods/Services	Class 016. First use: First Use: 0 First Use In Commerce: 0 Books and short stories in the field of detective fiction		

Related Proceedings	Opposer is filing concurrent Notices of Opposition to Applicant's Application Nos. 86603779 and 86603787. Opposer intends to file Notices of Opposition thereafter to Applicant's Application Nos. 86603780, 86603782, 86603784, and 86603776.
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Attachments	77937845#TMSN.png( bytes ) 86126503#TMSN.png( bytes ) 85447511#TMSN.png( bytes ) 77937813#TMSN.png( bytes ) 77937852#TMSN.png( bytes ) 77937863#TMSN.png( bytes ) 85229790#TMSN.png( bytes ) Notice of Opposition (86603772-Class 9).pdf(99883 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Benjamin Allison/
Name	BENJAMIN ALLISON

Date	02/07/2016
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

CONAN DOYLE ESTATE LTD.,

Opposer,

Opposition No.  
Serial Nos. 86603772

v.

UNIVERSAL CITY STUDIOS LLC,

Applicant.

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**NOTICE OF OPPOSITION**

Conan Doyle Estate Ltd., a United Kingdom corporation whose address is 9 London Road, Southampton Hants, SO15 2AE (Opposer), believes it will be damaged by registration of SHERLOCK HOMEBOY, Application Serial No. 86603787 (the Opposed Application) in class 9, and hereby opposes the same. Pursuant to 15 U.S.C. §§ 1052, 1063, and 1125, Opposer alleges as follows:

1. Opposer comprises the family of Sir Arthur Conan Doyle and owns trademark rights associated with Arthur Conan Doyle and his characters including Sherlock Holmes. Opposer owns Application Serial No. 77/937,845 for SHERLOCK HOLMES in class 9 for “Motion picture and television films featuring musical, dramatic, comedic and theatrical performance; prerecorded goods, namely, prerecorded audio and video cassettes, compact discs, and digital versatile discs all featuring audio books and stories in the field of detective fiction, motion picture and television films, animated cartoons, radio programs, music, and games; downloadable electronic publications in the nature of e-zines and electronic books in the field of detective fiction.”

2. Opposer also owns Reg. 4,690,745 and Reg. 4,313,984 for SHERLOCK HOLMES®, Application Serial Nos. 77/937,813, 77/937,852, and 77/937,863 for SHERLOCK HOLMES for a variety of other goods and services, and SHERLOCK HOLMES CONAN DOYLE ESTATE LTD and design, Serial No. 85/229,790. All of Opposer's pending applications have filing dates prior to the Opposed Application. Opposer also owns common law trademark rights in SHERLOCK HOLMES for a variety of goods and services, and in MR. HOLMES for motion pictures and related goods and entertainment services. Collectively these trademarks are referred to as Opposer's Marks.

3. Opposer uses and licenses Opposer's Marks in connection with a wide variety of goods and services, including prerecorded audio and video cassettes, compact discs, and digital versatile discs all featuring audio books and stories in the field of detective fiction, motion picture and television films, animated cartoons, radio programs, music, and games; books, audio and e-books, CD-ROM materials, comic books, graphic novels, playing cards, figures, gaming machines, and entertainment services.

4. Applicant Universal City Studios LLC is a United States company whose address is Universal City Studios, 100 Universal City Plz, Universal City, CA 91608-1085 (the Applicant). Applicant has filed application Serial No. 86/603,772 for SHERLOCK HOMEBOY (the Opposed Application), in addition to 6 other applications to register the same mark for other goods and services. *See* Serial Nos. 86/603,787, 86/603,779, 86/603,780, 86/603,782, 86/603,784, and 86/603,776.

5. The Opposed Application seeks registration based on an intent to use the Opposed Mark in connection with the following goods and services:



Pre-recorded media, namely, digital, audio, and video tapes and discs, CDs, DVDs, and MP3-players featuring books, music, television programs, movies or other entertainment audio-visual programming in the field of animation, cartoons, drama, action, adventure, science-fiction, romance and suspense; musical sound recordings; downloadable motion pictures, television programs and audio-visual entertainment programs in the field of animation, cartoons, drama, action, adventure, science-fiction, romance and suspense; downloadable ring tones, computer screen saver software, music files, images and videos featuring animation, cartoons, drama, action, adventure, science-fiction, romance, suspense, movie clips, television show clips and music video clips via a global computer network and wireless communication devices; downloadable computer game, video game and electronic game programs and software via a global computer network and wireless communication devices; downloadable interactive computer game, video game and electronic game programs and software via a global computer network and wireless communication devices; downloadable computer game software for use on mobile phones, cellular phones and tablets; video game software provided on CD or DVD, cartridges, and memory cards; interactive computer game video game and electronic game programs and software provided on CD or DVD, cartridges, and memory cards; video game cartridges, and video game memory cards; computer screen saver software; downloadable electronic publications, namely, series of fiction books, comic books and animated story books; mouse pads; protective carrying cases adapted for portable music players; protective covers and cases for mobile phones, tablets, and PDAs; speakers, audio headphones and earbuds; computer storage devices, namely, blank flash drives, calculating machines; decorative magnets; kitchen magnets; sunglasses; 3-D glasses; swim masks; mobile phone accessories namely, batteries, chargers, cables, phone cases, covers and gel-skins, phone charms, cell phone mounts for cars, phone clips and screen protectors; photographic cameras; radios (International Class – 009; US Classes 021, 023, 026, 036, and 038)

6. The Opposed Application was published for opposition in the *Official Gazette* on August 11, 2015. An extension of the period in which to file an opposition was requested and granted, and this Notice of Opposition is timely filed.

7. There is no question as to priority in this proceeding. Opposer's priority in Opposer's Marks predates any priority that may be claimed by Applicant.

8. The mark in the Opposed Application so resembles Opposer's Marks that, if used on the goods set forth in the Opposed Application, it is likely to cause confusion, mistake, and to deceive purchasers and potential purchasers into erroneously believing that Opposer is affiliated with or has authorized, sponsored, or licensed Applicant's goods, in violation of 15 U.S.C. § 1052(d).

9. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration would give Applicant prima facie evidence of ownership of an exclusive right to use a mark that is confusingly similar to Opposer's Marks, which rights will interfere with Opposer's use of its marks.

10. Opposer's Marks are distinctive and famous in the United States, being widely recognized as a designation source of Opposer's goods and services. Opposer's Marks became distinctive and famous long before the filing date of the Opposed Application.

11. Registration of the mark in the Opposed Application will damage Opposer because, if put into use for the goods listed in the Opposed Application, it is likely to cause dilution of Opposer's Marks in violation of 15 U.S.C. § 1125(c). Registration of SHERLOCK HOMEBOY will erode the public's exclusive identification of Opposer's Marks with Opposer and will tarnish and degrade the positive associations and prestigious connotations of Opposer's Marks.

12. At the time it filed the Opposed Application, Applicant had knowledge of Opposer's rights in SHERLOCK HOLMES. In spite of this knowledge, Applicant declared in support of the Opposed Application that to the best of its knowledge and belief no other person, firm, corporation, or association had the right to use the mark in the Opposed Application in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods or services of such other person, to cause confusion or to cause mistake or to deceive.

13. At the time Applicant signed the declaration, Applicant was aware of Opposer and of Opposer's senior rights in SHERLOCK HOLMES, and knew that Applicant's mark was so similar to Opposer's Marks as to be likely to cause confusion or mistake, or to deceive. Accordingly, Applicant knew that the declaration was false.

14. By submitting a knowingly false declaration regarding a material fact in order to procure a registration to which it is not entitled, Applicant has committed fraud on the Patent and Trademark Office.

WHEREFORE Opposer respectfully prays that registration of the Opposed Application be refused and that this opposition be sustained.

Dated: February 7, 2016

Respectfully submitted,

BARDACKE ALLISON LLP

By: /s/ Benjamin Allison  
Benjamin Allison  
Breanna Houghton

Post Office Box 1808  
Santa Fe, New Mexico 87504-1808  
(505) 386-4100

*Counsel for Opposer*  
*Conan Doyle Estate Ltd.*

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing Notice of Opposition was served February 7, 2016 by first class mail, postage prepaid to:

Tirzah Lowe  
Universal City Studios  
100 Universal City Plz  
Universal City, CA 91608-1085

BARDACKE ALLISON LLP

By /s/ Benjamin Allison